UNITED STATES PATENT AND TRADEMARK OFFICE

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09/518,048	03/02/2000	Robert Barritz	AUS920050920US1	5346

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EXAMINER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte ROBERT BARRITZ, PETER KASSAN, and
PER HELLBERG

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Appeal 2009-008004
Application 09/518,048
Technology Center 2400

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Before JOSEPH F. RUGGIERO, CARLA M. KRIVAK, and
CARL W. WHITEHEAD, JR., *Administrative Patent Judges.*

KRIVAK, *Administrative Patent Judge.*

DECISION ON APPEAL[1]

Appellants appeal under 35 U.S.C. § 134(a) from a final rejection of claims 34-43 and 46-51. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

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[1] The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the "MAIL DATE" (paper delivery mode) or the "NOTIFICATION DATE" (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

STATEMENT OF THE CASE

Appellants' claimed invention is a system for correlating software product inventory and usage information with license agreement information (Spec. 11:12-17).

Independent claim 34, reproduced below, is representative of the subject matter on appeal:

34. A substantially automatic system for correlating metrics associated with a plurality of software products installed on a computer with related software agreement data, the system comprising:

a first computerized software facility operable to interface with a respective software product API of at least one of the plurality of software products in order to obtain the related software agreement data;

a second computerized software facility operable to interface with the respective software product API of the at least one software product in order to obtain software product data;

a software facility API provided by at least one of the first computerized software facility and the second computerized software facility to enable the at least one software product interfaces to supply the related software agreement data or the software product data;

a third computerized software facility operable to correlate substantially automatically the software product data and the software agreement data with one another; and

a fourth computerized software facility operable to output results of said correlation, wherein the system is operable to display and report the results from the fourth computerized software facility, and wherein the system is not operable to affect operation of any software product identified by data correlated by the third computerized software facility.

REJECTIONS

The Examiner rejected claims 34, 35, 37-41, and 48 under 35 U.S.C. § 102(e) as anticipated by Franklin (US 6,105,069).

The Examiner rejected claim 36 under 35 U.S.C. § 103(a) based upon the teachings of Franklin.

The Examiner rejected claims 46, 47, 50, and 51 under 35 U.S.C. § 103(a) based upon the teachings of Franklin and Mangat (6,049,799).

The Examiner rejected claims 42 and 43 under 35 U.S.C. § 103(a) based upon the teachings of Franklin and Todd (US 5,867,714).

The Examiner rejected claim 49 under 35 U.S.C. § 103(a) based upon the teachings of Franklin and Elmasri ("Fundamentals of Database Design," 1989, pp. 544-545).

Appellants contend Franklin fails to teach all of the limitations of claim 34 (App. Br. 6-8; Reply Br. 1-5).

ISSUE

1.   Did the Examiner err in finding Franklin teaches or suggests Appellants' claimed invention?

FINDINGS OF FACT

1.   Franklin teaches "an application object 100 identifying certain important information associated with an actual executable file corresponding to an application" (col. 4, l. 66-col. 5, l. 1). An application object contains attributes 110 and has methods 108 for using certain attributes (col. 5, ll. 51-53; col. 8, ll. 26-28).

2.   The attributes contained in Franklin's application objects include licensing attributes 160 such as "authorizations, charges, and other administrative information required for licensing an application associated with an application object" (col. 6, ll. 27-30). The attributes also include "environment information, configuration information, and other data" (col. 6, ll. 41-43).

ANALYSIS

Rejection of claims 34, 35, 37-41, and 48 under 35 U.S.C § 102

Appellants argue this rejection with respect to claim 34 with claims 35, 37-41, and 48 relying on the same arguments (App. Br. 8).[2]

Appellants contend Franklin's executable file does not include an application program interface (API) to provide software agreement information (App. Br. 6). Appellants note Franklin discloses storing licensing information in objects "associated" with the executable file (App. Br. 6; Reply Br. 2-3) and that Franklin's licensing objects may be implemented as API's (App. Br. 7). However, Appellants contend, such API's are not "of" the respective software products, as claimed (App. Br. 7; Reply Br. 3, 4). Moreover, Appellants assert the licensing information Franklin's objects provide is not data from a software product or resource, rather it is from objects that represent a resource (Reply Br. 3). Appellants also contend Franklin's licensing objects do not implement a single API

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[2] Appellants recite "claims 35, 41-47, and 48" as being argued together with claim 34 regarding the 35 U.S.C. § 102 rejection (App. Br. 6, 8). However, the Examiner correctly identifies claims 34, 35, *37-41*, and 48 as the claims rejected under § 102 (Ans. 2). Thus, we consider Appellants' § 102 arguments with respect to claims 34, 35, 37-41, and 48.

providing both software agreement data and software product data (App. Br. 6, 7; Reply Br. 5). Further, Appellants contend Franklin teaches executing a resource, and thus does not teach a system that is "not operable to affect operation of any software product," as claimed (App. Br. 7-8; Reply Br. 3-4). We disagree.

Claim 34's recitation of "a respective software product API of at least one of the plurality of software products" is not patentably distinct from Franklin's application object that identifies information associated with an application (FF 1). Appellants' argue Franklin's "application objects 100 are not the software application (i.e., applicants' claimed 'software products') *per se*, but instead represent applications" (Reply Br. 3). However, this argument is not supported by the claim language. Claim 34 does not require the software product and its respective software product API to be one and the same. Moreover, claim 34 does not require the software agreement data to be obtained from the software product. Rather, claim 34 merely states the software facility interfaces "with the respective software product API . . . to obtain the related software agreement data," without specifying the location of the data. Further, Franklin's application objects provide both software agreement data and software product data (FF 2).

Appellants also argue Franklin requires executing a resource and thus fails to meet the limitation "the system is not operable to affect operation of any software product" (App. Br. 7-8; Reply Br. 3-4). This argument misconstrues claim 34. Based on the plain meaning of its terms, claim 34 requires the system not change or influence how certain software products operate. While Appellants note Franklin discloses launching a resource if

properly licensed, Appellants have not shown how the licensing control
required to launch a resource affects any executing resource (App. Br. 7;
Reply Br. 4). The question of whether to operate a software product at all is
different than how the software product operates once it is launched, and
claim 34 only relates to the latter.

Therefore, Franklin anticipates claim 34 along with claims 35, 37-41,
and 48.

Rejection of claims under 35 U.S.C. § 103

Appellants argue claim 36, which depends from claim 34, is not
obvious over Franklin for the reasons presented with respect to claim 34 and
present no additional substantive arguments (App. Br. 8). Appellants also
argue claims 42, 43, 46, 47, and 49-51, which depend from claim 34, are not
obvious over Franklin and the respective teachings of Mangat, Todd, and
Elmasri for the reasons presented with respect to claim 34 (App. Br. 8-9).
Appellants merely state Mangat, Todd, and Elmasri, respectively, fail to
supply the claim 34 limitation allegedly not taught by Franklin (*id.*).
However, "a statement which merely points out what a claim recites will not
be considered an argument for separate patentability of the claim" (37
C.F.R. § 41.37(c)(1)(vii)). Therefore, the obviousness rejections of claims
36, 42, 43, 46, 47, and 49-51 are sustained.

DECISION

The Examiner's decision rejecting claims 34-43 and 46-51 is
affirmed.

No time period for taking any subsequent action in connection with
this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv)(2010).

<u>AFFIRMED</u>

ELD

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